REMARKS

Claims 5–22 are pending in this application. Claims 8–11 and 14–18 are currently amended.

Claims 8–11 and 14–22 have been rejected under 35 U.S.C. 112, first paragraph, for lack of enablement.

The Applicant respectfully disagrees with the Examiner and submits that Applicant's invention as present claimed is reasonably enabled. Moreover, even assuming *arguendo* that the Examiner has specifically identified what information is missing from the specification, the Examiner has not specifically identified why one skilled in the art could not supply the information without undue experimentation.

Referring to the Manual of Patent Examining Procedure, Section 2164 *et seq.*, the standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), which postured the question: is the experimentation needed to practice the invention undue or unreasonable? (*see also In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Again, the test of

enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

As discussed by the Examiner, "pre-determining the amount of moisture on the test body" is a function of "storage time, storage temperature, [and] storage humidity levels," as well as the surface area of the test body. Furthermore, as stated by the Examiner, "the amount of moisture released by the test body will be highly influenced by the temperature of the integrity testing process." The Examiner notes that, "in order to establish a pre-determined pressure rise as being indicative of a leaky system, the temperature must be held constant," "if the temperature is very low only a small amount of moisture will be released," and "if the temperature is very high...the amount of moisture released will be substantial."

The Applicant submits that factors such as the temperature of the integrity testing system and process, and test body storage time, temperature, and humidity levels, are well within the ordinary skill in the art. In particular, the Examiner easily showed how simple it is to identify the gas-law variables that need to be controlled in the claimed apparatus and process. In addition, regarding the factors influencing moisture absorption by the test body, the Applicant submits that one skilled in the art would know how to construct a test body comprising a suitable amount of a moisture-absorbing material and how to charge the test body with moisture. For example, as stated in the specification of the present application on page 4, lines

26–27, "renewed absorption of moisture from the surroundings, with climate being constant, takes place after the test."

In light of the foregoing, the Applicant respectfully requests that the §112, first paragraph, rejection of claims 8–11 and 14–22 be reconsidered and withdrawn because (1) one skilled in the art can make and use the claimed invention, (2) and the Examiner has not specifically identified why one skilled in the art could not supply the information without undue experimentation.

Claims 5, 6, 12, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann in view of Yoshiga.

The Applicant respectfully disagrees with the Examiner and submits that the present invention as claimed is not obvious over Lehmann in view of Yoshiga. Specifically, even assuming *arguendo* that Lehmann may be properly combined with Yoshiga, the cited combination does not provide all of the features of the Applicant's invention as claimed.

The integrity testing system recited in independent claim 1 comprises "a test body (20) adapted to removably absorb a defined amount of moistness...whereby moisture is removed from the test body when a vacuum is generated in the vacuum chamber." Likewise, the process of independent claims 14 comprises "providing a test body, wherein a defined amount of moistness is removably supplied to the test body in advance...whereby moisture is removed from the test body."

In contrast to the Applicant's invention, neither Lehmann nor Yoshiga disclose or even suggest a test body adapted to removably absorb moisture. Lehmann and Yoshiga also do not disclose or even suggest deliberately removing moisture from the test body for the purpose of integrity testing the leak-testing system.

Lehmann discloses a method and apparatus for leak testing closed and filled containers, whereby the filling material comprises at least one liquid component. However, unlike the Applicant's invention, the closed containers of Lehmann cannot be adapted to removably absorb moisture; otherwise each and every closed container of Lehmann would leak when exposed to a vacuum. Taking the reference as a whole, Lehmann clearly does not disclose or even suggest leak-testing test bodies that always leak. Moreover, having disclosed closed and filled containers, the Applicant submits that, unlike the Applicant's invention, Lehmann does not disclose or even suggest deliberately removing the filling material for the purpose of integrity testing the leak-testing system. Taking the reference as a whole, Lehmann clearly does not desire that any closed container actually leak.

Yoshiga discloses, according to the English-language abstract, "an aerosol-can container which is excellent in corrosion-resistance is obtained in such a way that a metal laminate plate in which at lest [*sic*] one side of an aluminum plate or steel plate is covered with a polyamide resin layer is subjected to a spinning/ironing process so that the resin layer comes inside." The aerosol can of Yoshiga is not "primarily manufactured from polyamide" as asserted by the Examiner. In fact, the

Yoshiga aerosol canister, being a sealed container, is constructed with an external aluminum or steel plate. The Applicant submits that Yoshiga does not disclose or even suggest an aluminum or steel plated can, let alone a test body as claimed, that is adapted to removably absorb moisture. The Applicant also submits that Yoshiga does not disclose or even suggest an aluminum or steel plated can, let alone a test body as claimed, from which moisture can be deliberately removed by vacuum pressure.

In light of the foregoing, the Applicant respectfully requests that the §103(a) rejection of claims 5, 6, 12, and 13 based on Lehmann in view of Yoshiga should be reconsidered and withdrawn.

Claims 5, 7, 12, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann in view of Pope.

The Applicant respectfully disagrees with the Examiner and submits that the present invention as claimed is not obvious over Lehmann in view of Pope. Specifically, even assuming *arguendo* that Lehmann may be properly combined with Pope, the cited combination does not provide all of the features of the Applicant's invention as claimed.

For the reasons discussed above, the Applicant submits that Lehmann does not disclose or even suggest the features of the Applicant's invention as claimed.

Pope discloses aerosol containers made of plastics, such as polyoxymethylene. The aerosol containers of Pope are sealed containers. Therefore, the Applicant submits that Yoshiga does not disclose or even suggest a test body that is adapted to removable absorb moisture. Applicant also submits that Pope does not disclose or even suggest a test body from which moisture can be deliberately removed by vacuum pressure.

In light of the foregoing, the Applicant respectfully requests that the §103(a) rejection of claims 5, 7, 12, and 13 based on Lehmann in view of Pope should be reconsidered and withdrawn.

The Applicant respectfully requests favorable consideration.

Respectfully submitted,

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